

Appl. No. 09/595,583

REMARKS

Claims 14 and 40 are amended. Claims 17-18, 23-24, 35-39 and 59 are cancelled. Claims 14-16, 19-22, 25-34 and 40-44 are pending in the application.

The abstract stands objected to as failing to clearly and definitely reflect the essence of the invention. The Examiner indicates that the method of the present invention is directed specifically toward determining impurities in metal compositions by microscopic analysis. Applicant notes that the present abstract clearly indicates utilization of a microscope. Further, applicant notes that the present invention is not limited to analysis of impurities or analysis of metal compositions. For example, the specification at page 22, lines 6-10 clearly indicates that the method can be utilized for analysis of materials comprising an organic matrix. Accordingly, the present abstract clearly reflects the essence of the invention. Applicant therefore requests withdrawal of the objection to the abstract in the Examiner's next action.

The title of the invention stands objected to as failing to clearly indicate the invention to which the claims are directed. The Examiner suggests utilizing a title which specifies metal compositions and determining impurities. However as indicated above, the invention is not so limited. The title is amended to incorporate indication of use of a microscope as suggested by the Examiner. Accordingly, applicant respectfully requests withdrawal of the objection to the title in the Examiner's next action.

Claims 14-39 and 59 stand rejected under 35 U.S.C. § 112, first paragraph, for non-enablement. The Examiner indicates at pages 2-3 of the present Action that the specification does not provide enablement for generating information on dissolved material after dissolving the composition. Not one of the claims rejected by the Examiner recites

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generating information on undissolved materials. Accordingly, the Examiner's rejection based upon such grounds is improper.

The Examiner further indicates that the specification fails to enable generating information about the type of material related to its conductivity using a light microscope. However at page 2 of the present Action, the Examiner indicates that the specification enables generating information on size, shape, type and quantity of undissolved material with type relating to an oxide content and a carbon content. Applicant notes that the conductivity of a material relates to its content, such being well known to anyone of ordinary skill in the art. Accordingly, generating information regarding a type of undissolved material relating to oxide content and carbon content can provide information about the conductivity of the material. Accordingly, the Examiner's 112, first paragraph, rejection based upon such grounds is improper. The Examiner further indicates that "no one of ordinary skill in the art can determine the "size, shape, quantity or type" of a dissolved material using a microscope. None of the claims recite determining the size shape, quantity, or type of any dissolved material. Accordingly, the Examiner's rejection upon such grounds is improper.

The Examiner additionally bases the § 112, first paragraph, rejection upon the belief that the method is directed specifically toward determination of insoluble impurities in metal compositions. As indicated above, the invention is not so limited. Accordingly, applicant respectfully requests withdrawal of the rejection based upon these grounds in the Examiner's next action.

With respect to claims 35-39 and 59, without admission as to the propriety of the Examiner's rejections of these claims, such claims are cancelled from the application. The

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cancellation of such claims is intended to narrow the issues in the event of an appeal. Accordingly, applicant preserves the right to pursue the subject matter of such claims in this or a continuing application.

Claims 40-44 stand rejected under 35 U.S.C. § 112, first paragraph, based upon lack of enablement for the recited "modifying a light absorbing property". The Examiner indicates that the specification only enables modification by physically or chemically changing. Claims 40-44 stand additionally rejected under 35 U.S.C. § 112, second paragraph, as being incomplete for omitting essential steps of physical or chemical modification. Without admission as to the propriety of the Examiner's rejection, independent claim 40 is amended to recite modifying to change the light absorbing property by physical or chemical modification. The present amendment overcomes both the first and second paragraph rejections of claim 40 and claims 41-44 which depend therefrom.

Claims 14-44 and 59 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner indicates that the preamble which recites "a method of generating information about materials present in a composition" contradicts the body of the claim which recites processing data to generate information about one or more of the size, shape and quantity of undissolved material. The Examiner indicates that the preamble of the claim should be written to correspond to the body. Applicant notes that the undissolved material recited in the claim is present in the composition. Accordingly, generating information about the undissolved material can be used to generate information about materials present in the composition. Further, the

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claim indicates that the method of generating the information about the materials in the composition comprises the recited steps and is therefore not limited to the specific steps recited. Accordingly, the preamble is accurate and the further recited limitations specifically point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 14, the Examiner further indicates that the recited "a first depth of the composition" and "a second depth of the composition" imparts indefiniteness to the claim because "the composition by definition is just a mixture of several components it is not clear how a dimensionless mixture can have a depth". Although the Examiner's theory that a composition of matter can be dimensionless is truly amazing, the Examiner does not provide any foundation or support for this theory and such theory is therefore unfounded. Accordingly, applicant respectfully requests withdrawal of the rejection based upon such theory in the Examiner's next action.

With respect to claims 23-32 the Examiner indicates that the recited "the solution comprises one or more metals" renders the claim indefinite because it is not clear whether the metals are dispersed in the solution or dissolved. Such claims clearly indicate that metals are present in the solution. Applicant is not required to limit the claims to encompass only metals that are dissolved or only metals that are dispersed in the solution. Accordingly, the present rejection based upon failure to further limit the claims is improper.

Claims 14-17 and 21-34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pavate, U.S. Patent No. 6,001,227 in view of Meisburger, U.S. Patent No. 5,502,306. Without admission as to the propriety of the Examiner's rejection, claim 14

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is amended to incorporate subject matter of claim 18 which is not rejected based upon any prior art. Accordingly, independent claim 14 is allowable over the art of record.

Dependent claims 17, 18, 23 and 24 are cancelled. Dependent claims 15-16, 19-22 and 25-34 are allowable over the art of record for at least the reason that they depend from allowable base claim 14.

As indicated above, without admission as to the propriety of any of the Examiner's rejections claims 35-39 and 59 are cancelled.

The amendment to claim 40 overcomes the § 112 rejection of claims 40-44 as set forth above. Applicant acknowledges the Examiner's indicated allowability of claims 40-44 upon overcoming the 112 rejections. Accordingly, claims 40-44 are in condition for allowance.

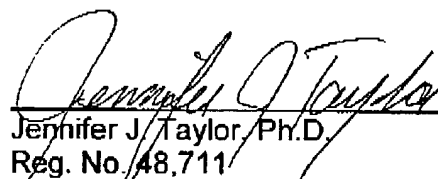
For the reasons discussed above pending claims 14-16, 19-22, 25-34 and 40-44 are allowable. Accordingly, applicant respectfully requests formal allowance of such pending claims in the Examiner's next action.

Respectfully submitted,

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By:


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